

Remarks

Claims 38-44, 46-66, 74-87, and 90-94 are pending in the subject application. Favorable consideration of the pending claims is respectfully requested.

Claims 83-85 and 93 are rejected under 35 USC §102(b) as being anticipated by Geier *et al.* (1997). The Examiner asserts that Geier *et al.* teaches a nucleic acid composition that hybridizes to SHIP-1 mRNA. Applicant respectfully traverses this ground of rejection

Applicant respectfully asserts that the cited reference does not teach or suggest the claimed invention. Applicant submits that it is clear from the disclosure in the Geier *et al.* reference that the nucleic acid therein is not used to reduce SHIP-1 expression; the oligonucleotide is used to amplify the 5' end of human p145 Ship. Moreover, the Geier *et al.* reference does not teach or suggest a nucleic acid or DNA in a pharmaceutically acceptable carrier. The Examiner has not indicated where a pharmaceutically acceptable carrier is provided in the Geier *et al.* reference. As the Examiner is aware, in order to anticipate, a single reference must disclose within the four corners of the document each and every element and limitation contained in the rejected claim. *Scripps Clinic & Research Foundation v. Genentech Inc.*, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). The Geier *et al.* reference does not teach or suggest each and every element of Applicant's claimed invention. Accordingly, reconsideration and withdrawal of the rejection under 35 USC §102(b) is respectfully requested.

Claims 38-44, 74-76, 83-87, 90, 93, and 94 are rejected under 35 USC §102(b) as being anticipated by Rohrschneider *et al.* (WO 97/10252). The Examiner asserts that Rohrschneider *et al.* discloses inhibition of SHIP-1 expression. Applicant respectfully traverses this ground of rejection.

Applicant respectfully asserts that the cited reference does not teach or suggest the claimed invention. Applicant respectfully submits that the WO 97/10252 reference does not teach or suggest methods of reducing SHIP-1 function; the WO 97/10252 reference only discloses that antisense sequences can be used to "block overexpression of SHIP or expression of mutant forms" (emphasis added). Blocking overexpression is not the same as reducing SHIP-1 function. Moreover, the WO 97/10252 reference does not teach or suggest a nucleic acid or DNA in a pharmaceutically acceptable carrier. The Examiner has not indicated where a pharmaceutically acceptable carrier is provided in the WO 97/10252 reference. For example, claims 15, 16, and 18 of the WO 97/10252 reference

indicated by the Examiner, which are directed to an oligonucleotide, do not recite a “pharmaceutically acceptable carrier.” As noted previously herein, in order to anticipate, a single reference must disclose within the four corners of the document each and every element and limitation contained in the rejected claim. *Scripps Clinic & Research Foundation v. Genentech Inc.*, *supra*. The WO 97/10252 reference does not teach or suggest each and every element of Applicant’s claimed invention. Accordingly, reconsideration and withdrawal of the rejection under 35 USC §102(b) is respectfully requested.

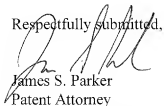
Claims 46-66, 77-82, 91, and 92 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 11/787,064. Applicant acknowledges that a terminal disclaimer can be filed to overcome this rejection and plans on submitting an appropriately executed terminal disclaimer. Accordingly, upon the Examiner’s indication of allowable subject matter in the subject application, a terminal disclaimer or other appropriate action will be taken.

In view of the foregoing remarks, Applicant believes that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account 19-0065.

Applicant invites the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



James S. Parker

Patent Attorney

Registration No. 40,119

Phone No.: 352-375-8100

Fax No.: 352-372-5800

Address: P.O. Box 142950

Gainesville, FL 32614-2950

JSP/mv